

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	Lise Wiseman et al.	Art Unit :	2194
Patent No. :	7,536,697	Examiner :	Li Zhen
Issue Date :	May 19, 2009	Conf. No. :	5383
Serial No. :	09/927,957		
Filed :	August 9, 2001		
Title :	INTEGRATING ENTERPRISE SUPPORT SYSTEMS		

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

Patentee hereby requests reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. Reconsideration of the final PTA calculation to increase total PTA from 1654 to 2182 days, is respectfully requested.

REMARKS

“A Delays” are defined as delays by the U.S. Patent and Trademark Office (PTO) under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt PTO response. “B Delays” are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. To the extent that the periods of delay overlap, the period of any term adjustment shall not exceed the actual number of days the issuance of the patent was delayed. 35 U.S.C. § 154(b)(2)(A). As outlined in Wyeth et al. v. Jon W. Dudas (580 F. Supp. 2d 138; 88 USPQ 2d 1538), the only way that these periods of time can “overlap” is if they occur on the same day. If an “A delay” occurs on one calendar day and a “B delay” occurs on another calendar day, they do not overlap and 35 U.S.C. § 154(b)(2)(A) does not limit the extension to one day. Id.

The PTA for the instant patent, as currently calculated and shown on the face of the patent, apparently relies on the premise that the application was delayed under 35 U.S.C. § 154(b)(1)(B) *before* the initial three-year period expired. The Wyeth v. Dudas court determined that this construction cannot be squared with the language of 35 U.S.C. § 154(b)(1)(B), which applies “if the issue of an original patent is delayed due to the

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Applicant : Lise Wiseman et al.
Patent No. : 7,536,697
Issued : May 19, 2009
Serial No. : 09/927,957
Filed : August 9, 2001
Page : 2 of 5

Attorney's Docket No.: 12587-0008001 / D01-001/01315-00/US

failure of the United States Patent and Trademark Office to issue a patent within 3 years.” “B delay” begins only after the PTO has failed to issue a patent within three years, not before. Id.

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

“A Delay”

A first PTO action was due on or before October 9, 2002 (the date that is fourteen months after August 9, 2001, the date on which the application was filed). The PTO mailed the first non-final Office Action on July 29, 2004, thereby according a PTO Delay of 659 days. Patentee does not dispute the PTO's calculation for this “A Delay” from October 10, 2002 (the day after the date that is fourteen months after the date on which the application was filed), to July 29, 2004. See 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1).

A PTO action was due on or before May 3, 2005 (the date that is four months after January 3, 2005, the date on which a response to Office Action was filed). The PTO mailed a non-final Office Action on June 28, 2005, thereby according a PTO Delay of 56 days. Patentee does not dispute the PTO's calculation for this “A Delay” from May 4, 2005 (the day after the date that is four months after the date on which a response to Office Action was filed), to June 28, 2005. See 37 C.F.R. §§ 1.702(a)(2) and 1.703(a)(2).

A PTO action was due on or before July 4, 2008 (the date that is four months after March 4, 2008, the date on which a response to Office Action was filed). The PTO mailed a non-final Office Action on July 9, 2008, thereby according a PTO Delay of 5 days. Patentee does not dispute the PTO's calculation for this “A Delay” from July 5, 2008 (the day after the date that is four months after the date on which a response to Office Action was filed), to July 9, 2008. See 37 C.F.R. §§ 1.702(a)(2) and 1.703(a)(2).

In view of the period of “A Delay” detailed above, the total “A Delay” for this patent should be calculated as 720 days.

Applicant : Lise Wiseman et al.
Patent No. : 7,536,697
Issued : May 19, 2009
Serial No. : 09/927,957
Filed : August 9, 2001
Page : 3 of 5

Attorney's Docket No.: 12587-0008001 / D01-001/01315-00/US

"B Delay"

The period beginning on August 10, 2004 (the day after the date that is three years after August 9, 2001, the date on which the application was filed), and ending May 19, 2009 (the date the patent was issued), is 1744 days in length.

"B Delay" may not include the number of days in the period beginning on the date on which a Request for Continued Examination was filed and ending on the date the patent was issued. In the present application, no Request for Continued Examination was filed.

See 37 C.F.R. §§ 1.702(b)(1) and 1.703(b)(1).

In addition, "B Delay" may not include the number of days in the period beginning on the date on which a Notice of Appeal was filed and ending on the date of mailing of a Notice of Allowance. In the present application, a Notice of Appeal was filed on March 17, 2006, and a non-final Office Action was mailed by the PTO on July 26, 2006, resulting in a period of 131 days that must be excluded from the three year delay calculation.

See 37 C.F.R. §§ 1.702(b)(4) and 1.703(b)(4).

In view of the periods of "B Delay" detailed above, the total "B Delay" for this patent should be calculated as 1613 days (i.e., 1744 days minus 131 days). The PTO calculated 1024 days of delay for issuance of a patent more than three years after filing. Patentee respectfully submits that the PTO's calculation of this "B Delay" is incorrect and that the correct PTO Delay for issuance beyond three years from filing is 1613 days. See 37 C.F.R. §§ 1.702(b) and 1.703(b).

Applicant : Lise Wiseman et al.
Patent No. : 7,536,697
Issued : May 19, 2009
Serial No. : 09/927,957
Filed : August 9, 2001
Page : 4 of 5

Attorney's Docket No.: 12587-0008001 / D01-001/01315-00/US

Overlap of "A Delay" and "B Delay"

As detailed above, "A Delay" accumulated during the following period:

October 10, 2002 to July 29, 2004;

May 4, 2005 to June 28, 2005; and

July 5, 2008 to July 9, 2008.

As detailed above, "B Delay" accumulated during the following period:

August 10, 2004 to May 19, 2009.

As such, the periods of "A Delay" and "B Delay" overlap (i.e., occur on the same calendar day) for a total of 61 days, from May 4, 2005 to June 28, 2005 and from July 5, 2008 to July 9, 2008.

Applicant Delay

A reply to an Office Action was due on or before October 29, 2004 (the date that is three months after July 29, 2004, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on January 3, 2005, thereby according an Applicant Delay of 66 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from October 30, 2004 (the day after the date that is three months after the date on which the Office Action was mailed) to January 3, 2005. See 37 C.F.R. § 1.704(b).

A reply to an Office Action was due on or before February 28, 2006 (the date that is three months after November 29, 2005, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on March 17, 2006, thereby according an Applicant Delay of 17 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from March 1, 2006 (the day after the date that is three months after the date on which the Office Action was mailed) to March 17, 2006. See 37 C.F.R. § 1.704(b).

Terminal Disclaimer

This patent is not subject to a terminal disclaimer.

Applicant : Lise Wiseman et al.
Patent No. : 7,536,697
Issued : May 19, 2009
Serial No. : 09/927,957
Filed : August 9, 2001
Page : 5 of 5

Attorney's Docket No.: 12587-0008001 / D01-001/01315-00/US

Conclusion

In consideration of the events described above, Patentee believes the PTA calculation of 1654 days is incorrect. As such, Patentee respectfully requests reconsideration of the PTA in the following manner:

- 1) Total PTO Delay should be calculated as 2272 days (i.e., the sum of 720 days of "A Delay" and 1552 days of "B Delay");
- 2) Total Applicant Delay should be calculated as 90 days (i.e., the sum of 66 days, 17 days, and 7 days); and,
- 3) Total PTA should be calculated as 2182 days.

The fee of \$200 required under 37 C.F.R. § 1.18(e) is being submitted herewith. Please apply any charges or credits to Deposit Account No. 06-1050, referencing attorney docket number 12587-0008001.

Respectfully submitted,

Date: July 20, 2009

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